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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,697	10/31/2001	Frank J. Kronzer	NPI-14 (16326.1)	2526
22827	7590	10/31/2006	EXAMINER	
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			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/003,697

Applicant(s)

KRONZER, FRANK J.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-42, 52-62 and 65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-51, 63 and 64 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 58 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 recites "an opaque crosslinked polymer layer overlying said peelable film layer; placing the peelable film layer on the surface with the opaque crosslinked polymer layer exposed". If the opaque crosslinked polymer layer overlies the peelable film, then the peelable film cannot be placed on the exposed side of the opaque crosslinked polymer layer as the peelable layer requirement is under the opaque layer.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-42, 52-62 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,916,751 to Kronzer in view of USPN 5,468,532 to Ho et al.

Kronzer claims a heat transfer material comprising a base substrate; a first layer overlying the base substrate; a second layer overlying the first layer where both first and second layers are melt-flowable at a transfer temperature; and a release layer therebetween. The same melting ranges are claimed also (instant claims 61-65). See patented claims 1-20. Despite the difference in wording to a non-transferable portion and transferable portion, the same layers, made of the same material, in the same structure is claimed by Kronzer, and thus would be expected to perform in the same way as presently claimed. See col. 4, lines 55-57 and Abstract. The results from causing the peelable film to melt and flow (claim 58) and that the polymer layer doesn't become fluid at a transfer temperature (claims 58-65) is also inherent as the same materials are employed. Kronzer does not claim the first layer having pigment and a crosslinker. Ho teaches crosslinking agents epoxy and polyfunctional aziridine are incorporated with acrylic polymers in thermal transfer media in ink compositions containing white pigment in one or two continuous or discontinuous layers (col. 3, lines 28-45, col. 4, lines 1-21 and 55-68, and col. 5, lines 1-5, FIG. 1 and 2) serving to adjust melt flow characteristics (Examples and Abstract).

It would have been obvious to one of ordinary skill in the art to have modified the heat transfer of Kronzer to have included crosslinking agents epoxy and polyfunctional aziridine incorporated with acrylic polymers in thermal transfer media in ink compositions containing

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white pigment in a continuous or discontinuous layers as claimed because the composition serves to adjust melt flow characteristics (col. 3, lines 28-45, col. 4, lines 1-21 and 42-68, and col. 5, lines 1-5, FIG. 1 and 2, Examples and Abstract of Ho).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-40, 42, 52-54, 56-57, 59-62, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,863,781 to Kronzer in view of USPN 5,468,532 to Ho et al.

Kronzer teaches a heat transfer material and method comprising: a substrate layer of paper webs or plastic films (instant claims 42, 47, and 56) (Kronzer, 12, FIG 1 and associated text); a release coating layer of acrylic polymer ethylene-methacrylic acid copolymer (Kronzer, 18, FIG 1 and associated text; col. 5, lines 44-45) (instant claims 40, 45, 54 and 61-inherent melt temperature); a peelable film layer overlying said release coating layer, wherein said peelable film layer is melt-flowable at a transfer temperature (Kronzer, Abstract and 20, FIG 1 and associated text, functional equivalency to conformable layer as in Applicant's specification, page 8, [0025] where the peelable layer is to conform to a substrate made of a melt index less than 800 as determined by ASTM D1238-82; see col. 3, lines 33-40 and col. 5, lines 15-26 of Kronzer teaching conformable layer is of the same ethylene vinyl acetate copolymer and wax (instant claims 31, 39, and 52-53) having a melt index greater than 30 to assist in the transfer of vinyl ink because of its inherent nature it will when heated soften and flow) ; and a polymer layer

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including an opacifying material, said opaque polymer layer overlying said peelable film layer (Kronzer, 22, FIG 1 and associated text, printed vinyl resin white ink (instant claim 32, 35), see col. 3, line 39, col. 4, lines 15-21 and lines 50-55, col. 5, lines 15-65, and col. 6, line 25).

Kronzer generally discloses a vinyl ink (22, FIG. 1 and associated text) that is either continuous or discontinuous layers, but does not teach a crosslinking agent /crosslinked polymer or printable layer, or that the pigment is white, or that it is of epoxy or multifunctional aziridine in adjacent opaque crosslinked layers (instant claims 31-35, 36-37, 52, 57, and 59-60).

Ho teaches a specific vinyl ink comprised of crosslinking agents epoxy and polyfunctional aziridine, incorporated with acrylic polymers, a species of vinyl, (crosslinking agent + resin binder, forming crosslinked polymer) containing white pigment in continuous or discontinuous adjacent layers (col. 3, lines 28-45, col. 4, lines 1-21 and 55-68, col. 5, lines 1-10 and col. 7, line 51) in thermal or hot transfer media in ink compositions for improving various physical properties including dimensional stability and melt flow characteristics (Examples and Abstract).

It would have been obvious to one of ordinary skill in the art to have modified the heat transfer of Kronzer to use the ink of Ho as polymer or printable layers as claimed because the composition serves to improve various physical properties including dimensional stability and melt flow characteristics (col. 3, lines 28-45, col. 4, lines 1-21 and 42-68, col. 5, lines 1-10 and col. 7, line 51, Examples and Abstract of Ho).

Regarding instant claims 38, 62 and 65, the capability of being able to be printed by an ink jet printer and not becoming fluid at a transfer temperature is met because the materials used in the crosslinked printable layer is the same. Also regarding the non-transferable and

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transferable portions, despite the difference in wording to a non-transferable portion and transferable portion, the same layers, made of the same material, in the same structure is claimed by Kronzer, and thus would be expected to perform in the same way as presently claimed.

Claims 41, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,863,781 to Kronzer in view of USPN 5,468,532 to Ho et al. and further in view of USPN 5,879,790 to Sogabe et al.

Kronzer and Ho are applied above.

Kronzer nor Ho teach a release-modifying agent (instant claims 41 and 55).

Sogabe teaches a color ink layer containing the same coloring agent, binders of vinyl resins and epoxy resins used in combination with a release layer in order to adjust the melt index in heat or thermal transfer sheets. Sogabe teaches release-modifying agents such as wax and heat-meltable resins such as acrylic resins are used in combination within release layers for the purpose of assisting in transfer and adjusting melt flow (col. 5, lines 3-68-col. 6, lines 10, col. 5, line 40-68 – col. 6, line 7 and Table 1).

It would have been obvious to one of ordinary skill in the art to have modified the heat transfer of Kronzer and Ho to use release-modifying agents because Sogabe teaches release-modifying agents help adjust melt flow and assist in overall transferability in heat transfers (col. 5, line 40-68 – col. 6, line 7 of Sogabe).

***Allowable Subject Matter***

Claims 43-51, and 63-64 are allowed.

The following is an examiner's statement of reasons for allowance: The applied prior art does not teach or suggest a heat transfer material comprising crosslinked printable polymer layer

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having an opacifying material, and a crosslinked printable polymer layer in the order as per instant claim 43.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim 58 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

### *Response to Arguments*

Applicant's arguments filed 07-10-06 have been fully considered but they are not persuasive.

Applicant does not contest the non-statutory double patenting and is in agreement with considering providing a terminal disclaimer to overcome the rejection, but has not submitted the terminal disclaimer to date. Thus, the Double Patenting rejection is sustained.

Applicant argues the combination of Kronzer and Ho over the use of a crosslinked polymer in the release layer 20 and barrier layers. Applicant has not persuasively argued because the Examiner did not refer to modifying the release layer with a crosslinking agent, but used the crosslinking properties for modifying the ink 22, not release 20 as set forth above.

Arguments to claims 43-51, 58, and 63-64 are moot in view of the allowable subject matter set forth above (and the 112 rejection to claim 58).




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***Conclusion***

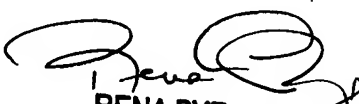
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Tamra L. Dicus  
Examiner  
Art Unit 1774

October 18, 2006

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
Art Unit 1774  
10/27/06